

## REMARKS

In accordance with the foregoing, claims 2 and 20 are amended for correction of formalities and new claim 21 is presented. No new matter is being presented, and approval and entry are respectfully requested. Claim 1 is cancelled without prejudice or disclaimer.

Claims 2 and 20-21 are pending and under consideration. Reconsideration is respectfully requested.

### Request For Interview

If the present application not found in condition for allowance after Examination of the present Request For Reconsideration, Applicants request an opportunity to conduct an in-person interview between the Applicants' representative and the Examiner, especially in view of the current case having been assigned to another Examiner.

### Current Action is Incomplete

Applicants respectfully submit that the current Office Action is incomplete since the Examiner has not responded to all of Applicants arguments traversing the rejections from the previous Office Action mailed October 2, 2006 ("previous Office Action") that were submitted in the previous Amendment filed February 7, 2007 ("previous Amendment"). As set forth in MPEP §707.07(f) entitled Answer All Material Traversed:

an examiner must provide clear explanations of all actions taken by the examiner during prosecution of an application.

In the previous Amendment, Applicants traversed the rejection of claim 2 under 35 U.S.C. §103(a), arguing, in part, there is no motivation to modify Burge et al. (U.S.P. 6,014,638)) with teachings of Welsh et al. (U.S.P. 6,757,691) since Burge is directed to determining a need and a certain user's needs and preferences, while Welsh is directed, instead, to predictive behavior for "the ability to categorize(d) groups of users or people who like a certain product for ease in mass marketing (emphasis added)."

Further, in the previous Amendment, Applicants requested the Examiner provide a citation to Burge's asserted "sign-in step," the elimination of which the Examiner relies on as a motivation in support of the rejection.

In support of the rejections in the current Office Action, the Examiner has not addressed the Applicant's previous argument and has repeated the assertion of elimination of a sign-in step as a motivation to modify Burge, but has not addressed Applicants request for a citation to such a "sign-in step".

### Summary

Applicants respectfully request that the finality of the current Office Action be withdrawn

and another action issued including a complete response and with the due date accordingly reset.

**Traverse Of claims 2 and 20 under rejection under §103(a)**

In items 3-5 of the Office Action, the Examiner rejects claims 2 and 20 under 35 U.S.C. §103(a) as being unpatentable over Burge et al. (U.S.P. 6,014,638) in view of Vatanen (U.S.P. 6,237,093) and further in view of Welsh et al (U.S.P. 6,757,691). The rejections are traversed.

As provided in MPEP §2143.03 "To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F. 2d 1981, (CCPA 1974)." Applicants submit that recited features are not taught by the cited art, alone or in *arguendo* combination. Claim 20, for example, recites a information presentation device including:

(a) "an acceptor accepting a selection of a product or service that is included in said products or services that were retrieved based on the search parameters designated by the user;" and

(b) "a parameter storage storing said search parameters for the selected product. . . ;" and

(c) "a user reference request acceptor accepting user reference requests from a first group of computer terminals on said network;" and

(d) "a parameter provider"

(d1)"extracting from said parameter storage"

(d1a) "a first user identification information identifying said first user terminals that have selected a first product as a candidate for purchase. . . ," and

(d1b) "search parameters that each of said first user terminals has set to said first product," and

(d2) "providing them to said provider terminal;" and

(e) "an information setter receiving from said provider terminal"

(e1) "the designation of user identification information included in said first user identification information provided to said provider terminal," and

(e2) "product information settings for said designated user identification information;"

(f) "a product information storage storing"

(f1) "said designated user identification information, said first product," and

(f2) "the product information that was set;" and

(g) "an information presenter"

(g1) "receiving a purchase candidate reference request from a designated user terminal identified by said designated user identification information,"

(g2) "extracting from said parameter storage candidates for purchase that correspond to said designated user identification information,

(g3) "extracting said product information set for said first product that is included in said candidates for purchase from said product information storage," and

(g4) "providing the extracted candidates for purchase and said product information to said designated user terminal." (emphasis added). Claim 2 has a similar recitation.

The art relied on by the Examiner, even in combination, does not teach such a device receiving a purchase candidate reference request and extracting product information set for a first product that is included in candidates for purchase from product information storage and "providing the extracted candidates for purchase and said product information to a designated user terminal.

As an example of an embodiment of the present invention, a provider terminal receives a purchase candidate reference request from a user and extracts product information set for a first product from the product information storage. A first product can be included in candidates for purchase that correspond to the user and the provider terminal provides the product information in addition to the candidates to the user. Accordingly, such a device enables a provider to extract a user's needs over a network without much burden to a user, and to increase sales of products and/or service provided over a network by using the extracted needs.

The art, alone or in combination, does not teach a device in which a product provider receives the user's navigational choices (for example, corresponding to purchase candidate reference request in the present invention) or a list of products in which the user is interested (for example, corresponding to candidates for purchase in the present invention) from a user.

By contrast, Burge is directed to a system which stores each user's personal information and behavior information on online shopping, extracts products suitable for a user based on his/her personal information and behavior information, and presents the extracted products to the user. By contrast, Vatanen is directed to a user verification through a network.

Further, in item 4 of the Office Action concedes that:

neither Burge et al. or Vatanen disclose ". . .accepting user reference requests from first group of computer terminals on said network parameter providing means for extracting from said parameter storage means a first user identification information identifying said first user terminals that have selected a first product as a candidate for purchase that is provided by an

administrator of a provider terminal included in said first computer terminals, . . . providing the extracted candidates for purchase and said product information to said designated user terminal".

(Action at page 3, line 9 - page 4, line 6).

Welsh is directed to marketing based on a predicted behavior.

Applicants submit that the cited art, alone or in combination, does not teach a configuration where a product provider receives the user's navigational choices (*arguendo* corresponding to the recited "purchase candidate reference request") or a list of products in which the user is interested (*arguendo* corresponding to the recited "candidates for purchase") from a user. Rather, even the *arguendo* combination of the art relied on by the Examiner merely teaches a system which provides products with a user based on the user's navigational choices.

#### **No Motivation To Combine The Art**

Applicants submit there is no motivation to combine the art in a manner as suggested by the Examiner.

The Examiner asserts, however, there is motivation to modify Burge in view of Vatanen: to use the terminal ID of the user, the motivation being the elimination of the sign-in step of Burge.

(Emphasis added, Action at page 3, lines 7-8).

The Examiner further asserts there is motivation to modify Burge (and Vatanen) with Welsh for:

the ability to categorize(d) groups of users or people who like a certain product for ease in mass marketing.

(Action at page 5, lines 13-14).

The USPTO Deputy Commissioner for Patent Operations, in view of a recent U.S. Supreme Court Decision, i.e., *KSR Int'l Co. v. Teleflex, Inc.*, No. 04-1350 (U.S. Apr. 30, 2007), issued a Memorandum on May 3, 2007 to the USPTO Technology Center Directors to provide interim guidance on establishing *prima facie* obviousness. The Deputy Commissioner asserted:

[I]n formulating a rejection under 35 U.S.C. §103(a) based upon a combination of prior art elements, it remains necessary to identify the reason why a person of ordinary skill in the art would have combined the prior art elements in the manner claimed.

(Emphasis added).

Applicants submit the Examiner has not adequately supported the finding of *prima facie* obviousness. In particular, the Examiner has not provided a citation to Burge's alleged "sign-in step," the elimination of which the Examiner is using as a motivation in support of the rejection. Applicants again request a citation to Burge's teaching of a "sign-in step" or an

statement by the Examiner along with an affidavit explaining the same, if an allowance is not provided.

Burge is directed to "determining a need and a certain user's needs and preferences" not a mass marketing and Vatanen is not concerned with mass marketing at all. Applicants submit one of ordinary skill in the art would modify a system for customizing user displays with Vatanen's procedure for setting up a secure service connection in a communication system. That is, one of ordinary skill in the art would not modify Burge (and Vatanen) with Welsh's teachings directed to predictive behavior for "the ability to categorize(d) groups of users or people who like a certain product for ease in mass marketing." (Action at page 5).

### Summary

Since *prima facie* obviousness is not established, the rejection should be withdrawn and claims 2 and 20 allowed.

### New Claim

New claim 21 is presented to recite features to recite features of the invention in a different fashion. Claim 21 recites a device including "a user terminal of a plurality of user terminals on a network retrieves products or services that match settable values of changeable search parameters designated by a user of the respective user terminal, . . . comprising: . . . an acceptor accepting a selection of a product or service . . . retrieved based on changeable search parameters designated by the user of the respective user terminal; a parameter storage storing said changeable search parameters . . . ; a user list reference request acceptor accepting user list reference requests from a group of computer terminals. . . ; a parameter provider extracting . . . user identification information identifying those user terminals that have selected a certain product or service as a candidate for purchase. . . , and a set value of those search parameters of the changeable search parameters that each of said user terminals has set for said selected product or service, and providing the set values to said provider terminals . . ." (Emphasis added).

Support for claim 21 includes, for example, Fig. 1 and page 22, line 8 of the specification discussing a device having a "plurality of user terminals," Fig. 11 and page 34, line 10 to page 35, line 18 of the specification discussing a device including "settable values of changeable search parameters," and Fig. 4C and Fig. 12, and page 36, line 13 to page 39, line 3 of the specification discussing a device including "a user list reference request acceptor accepting user list reference requests."

Applicants submit that that none of the art, alone or in combination, currently relied on by

the Examiner teach a device collecting information from a plurality of user terminals into a list and in which information is provided by each user terminal as a value set for a changeable search parameter and in which the search parameter is changeable by the user. Further, none of the art currently relied on, alone or in combination, teach a provider providing a selected product or service group based on the set values of the user changeable parameters.

By contrast, Walsh merely teaches a predictive content system with a selection of content choices being given to a user (see, for example, col. 8, lines 59, 64). Burge merely customizes a content of a group of users computers, and Vatanen teaches authorization means. An *arguendo* combination of the art currently relied on merely teaches a predictive content system with customization of content of a group of computers with a means for authorization.

### **Summary**

Claim 21 is submitted to distinguish patentably over the art currently relied on by the Examiner, and to be allowable for the recitations therein.

### **CONCLUSION**

In accordance with the foregoing, it is respectfully submitted that all outstanding objections and rejections have been overcome and/or rendered moot, and further, that all pending claims patentably distinguish over the prior art. Thus, there being no further outstanding objections or rejections, the application is submitted as being in condition for allowance which action is earnestly solicited.

If the Examiner has any remaining issues to be addressed, it is believed that prosecution can be expedited by the Examiner contacting the undersigned attorney to discuss resolution of such issues.

If there are any underpayments or overpayments of fees associated with the filing of this Amendment, please charge and/or credit the same to our Deposit Account No. 19-3935.

Respectfully submitted,

STAAS & HALSEY LLP

Date:

July 16, 2007

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